

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q90107

Heinz FOCKE, et al.

Appln. No.: 10/550,890

Group Art Unit: 3782

Confirmation No.: 3733

Examiner: Christopher R. DEMEREE

Filed: September 27, 2005

For: FOLDING BOX FOR CIGARETTES

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37
U.S. Appln. No. 10/550,890

Attorney Docket No. Q90107

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is FOCKE & CO. (GMBH & CO. KG), Germany.

The assignment was recorded September 27, 2005, at Reel 017834, Frame 0695.

II. RELATED APPEALS AND INTERFERENCES

To the knowledge and belief of Appellant, the Assignee, and the Appellant's legal representative, there are no other appeals or interferences before the Board of Appeals and Interferences that will directly affect or be affected by the Board's decision in the instant Appeal.

III. STATUS OF CLAIMS

Claims 1-11, 16 and 17 have been canceled.

Claims 12-15 and 18-20 are pending in the application.

Claims 12-15 and 18-20 stand rejected and are the subject of this appeal.

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IV. STATUS OF AMENDMENTS

No Amendments have been filed subsequent to the final rejection.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The summary of the invention in connection with claims 12-15 and 18-20 in relation to exemplary embodiments are set forth below. The page and line numbers refer to the page and line numbers of the specification as filed.

The present invention provides a cigarette pack of the hinge-lid type that achieves an optimum conformation of its shape to the outer form or contour of the pack's contents, which consists of a cigarette group.

18. Hinge-lid pack for cigarettes (10) comprising a box part (element 11; page 3, line 18) with box front wall (element 14; page 3, line 23), a box rear wall (element 16; page 3, line 24), box side walls (element 22; page 4, line 3) and a base wall (element 15; page 3, line 24), a lid (element 12; page 3, line 18) which is pivotably attached to the box part (11) and which comprises a lid front wall (element 19; page 3, line 24-25), a lid rear wall (element 17; page 3, line 24), lid side walls (element 23; page 4, line 3) and an end wall (element 18; page 3, line 24), and a collar (element 13; page 3, line 18), made from a separate blank, being positioned within an upper part of the box part (11), **characterized by** the following features:

- a) the hinge-lid pack with box part (11) and lid (12) is configured as having an octagonal cross-section across its entire dimensions,
- b) a lateral region facing the box side walls (22) and lid side walls (23) is configured as having a cross-section that is trapezoid in shape, with converging material strips, namely legs

(elements 28, 29; 30, 31; page 4, line 12), connected respectively to the box front wall (14), box rear wall (16) and to the lid front wall (19) and lid rear wall (17),

- c) the width of the legs (28, 29; 30, 31) is greater than the diameter of one cigarette (10) yet less than the aggregate diameter of two adjacent cigarettes (10),
- d) the legs (28, 29; 30, 31) are directed at an angle (element 39; page 4, line 20) of approximately 30° to the box front wall (14) and box rear wall (16), and to the lid front wall (19) and lid rear wall (17), respectively, and are directed at an angle (element 40; page 4, line 23) of approximately 60° to the transverse box side wall (22) and lid side wall (23),
- e) a cigarette group (34), as the pack's contents, comprises transverse rows of said cigarettes, namely transverse rows (element 35; page 4, line 30-31) with two adjacent cigarettes (10) and transverse rows (element 36; page 4, line 30-32) with three adjacent cigarettes (10),
- f) the cigarettes (10) of the adjacent transverse rows (elements 35 and 36; page 4, line 30-32) are arranged in a saddle position, i.e. are offset to one another,
- g) cigarettes (10) of a marginal transverse row (35) of two adjacent cigarettes (10) are arranged in the region of angulations (element 37; page 5, line 8-9) between a box side wall (22) and lid side wall (23), on one hand, and box legs (element 28; page 4, line 12) and lid legs (element 30; page 4, line 12), on the other hand,
- h) marginal cigarettes of an adjacent transverse row (36) with three cigarettes (10) are arranged in the region of an angulation (element 38; page 5, line 8-9) between the box legs (28) and lid legs (30), on one hand, and box front wall (14), box rear wall (16), lid front wall (19) and lid rear wall (17), on the other hand.

19. Hinge-lid pack for cigarettes (10) comprising a box part (element 11; page 3, line 18) with box front wall (element 14; page 3, line 23), box rear wall (element 16; page 3, line 24), box side walls (element 22; page 4, line 3) and base wall (element 15; page 3, line 24), and a lid (element 12; page 3, line 18) which is pivotably attached to the box part (11) and which comprises lid front wall (element 19; page 3, line 24-25), lid rear wall (element 17; page 3, line 24), lid side walls (element 23; page 4, line 3) and end wall (element 18; page 3, line 24), **characterized by the following features:**

- a) box part (11) and lid (12) are configured as having a matching octagonal cross-section,
- b) a region facing at least one of the box side walls (22) and lid side walls (23) is configured as having a cross-section that is trapezoid in shape, with converging material strips or legs (elements 28, 29; 30, 31; page 4, line 12) connected respectively to the box front wall (14), box rear wall (16) and to the lid front wall (19) and lid rear wall (17), said legs (28, 29; 30, 31) having a width that is greater than the diameter of one cigarette (10) of said cigarettes and less than the aggregate diameter of two adjacent ones of said cigarettes (10).
- c) the material strips or legs (28, 29; 30, 31) are directed at an angle (element 39; page 4, line 20) of approximately 30° to the box front wall (14) and box rear wall (16), and to the lid rear wall (17) and lid front wall (19), respectively, and are directed at an angle (element 40; page 4, line 23) of approximately 60° to the transverse box side wall (22) and lid side wall (23),

- d) a collar (element 13; page 3, line 18) made from a separate blank conforms to the contour or cross-sectional profile in the region of the legs (28, 29; 30, 31) to form material strips (elements 50, 51; page 7, line 9) that are arranged at an angle to one another,
- e) attached to the marginal material strip (element 51; page 7, line 9) of the collar (13) is a collar leg (element 53; page 7, line 13) which abuts the inner side of the rear box legs (element 29; page 7, line 14) and lid legs (element 31; page 7, line 14-15).

Although the above summary refers to portions of the specification and drawings, the references are not meant to be limiting, but rather provide examples of the disclosed exemplary embodiments.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 12-15 and 18-20 are pending in the application and stand twice rejected.

The rejection of claims 12-15 and 18-20 is being appealed.

The ground of rejection to be reviewed on appeal is:

- 1) Claims 12-15 and 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. Pub. No. 2002/0179464 to Focke *et al.* (hereinafter "Focke"), in view of U.S. Patent No. 6,832,677 to Bohdan *et al.* (hereinafter "Bohdan").

VII. ARGUMENT

A. Claims 12-15 and 18-20 are patentable over the combination of Focke and Bohdan.

This rejection is in error since the Examiner has not established a prima facie case of obviousness over the combination of Focke and Bohdan.

Claims 12-15 and 18-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. Pub. No. 2002/0179464 to Focke *et al.* (hereinafter "Focke"), in view of U.S. Patent No. 6,832,677 to Bohdan *et al.* (hereinafter "Bohdan"). Applicant respectfully submits that this rejection is in error and should be withdrawn since, as explained below, it would not have been obvious to one of ordinary skill in the art at the time the invention was made to combine the references as attempted by the Examiner.

With respect to independent claim 18, the combination of Focke and Bohdan does not disclose or suggest at least a hinge-lid pack for cigarettes "having an octagonal cross-section across its entire dimensions, ... d) the legs (28, 29; 30, 31) are directed at an angle (39) of approximately 30° to the box front wall (14) and box rear wall (16), and to the lid front wall (19) and lid rear wall (17), respectively, and are directed at an angle (40) of approximately 60° to the transverse box side wall (22) and lid side wall (23), e) a cigarette group (34), as the pack's contents, comprises transverse rows of said cigarettes, namely transverse rows (35) with two adjacent cigarettes (10) and transverse rows (36) with three adjacent cigarettes (10), f) the cigarettes (10) of the adjacent transverse rows (35 and 36) are arranged in a saddle position, i.e. are offset to one another, g) cigarettes (10) of a marginal transverse row (35) of two adjacent

cigarettes (10) are arranged in the region of angulations (37) between a box side wall (22) and lid side wall (23), on one hand, and box legs (28) and lid legs (30), on the other hand, h) marginal cigarettes of an adjacent transverse row (36) with three cigarettes (10) are arranged in the region of an angulation (38) between the box legs (28) and lid legs (30), on one hand, and box front wall (14), box rear wall (16), lid front wall (19) and lid rear wall (17), on the other hand," as recited in the claim.

Focke discloses a hinge-lid cigarette pack with a box part, lid, and collar, and having a configuration of the upright pack edges as beveled edges (Abstract; FIG. 1). Applicant respectfully submits that the Examiner's conclusion concerning the claimed features of the exemplary embodiment of the present invention with respect to Focke is not supported. Absent impermissible use of hindsight provided by Applicant's disclosure, it would not have been obvious to one of ordinary skill in the art at the time the invention was made to configure the contour of the pack in such a manner that material strips are positioned at an angle of 30° or 60°.

The cigarette pack of Focke is based on changing a conventional, cuboid-shaped cigarette pack having right-angled pack corners to such a degree that the pack's design would conform more closely to its contents. Thus, the contour of the pack is adapted to the dimensions of the (four) corner cigarettes. On the other hand, the pack of the present exemplary embodiment has a contour that alters the effective spatial volume of the pack. While the cigarettes in the packs of Focke are arranged in the 7-6-7 formation common to standard hinge-lid packs, the cigarette pack of the present exemplary embodiment is associated with a special cigarette formation. See

FIGS. 9 and 10 of Applicant's specification. As illustrated in the figures, the presently claimed embodiment requires a cigarette formation oriented to transversely directed rows of cigarettes.

Furthermore, the cigarette formation employed in the pack of the present exemplary embodiment is not only adapted to conform to the pack's dimensions, but also to its contour. The dimensions of the material strips 28, 29, as well as of the side walls 22, not only conform to each other but also to the dimensions resulting from the transverse cigarette rows with different numbers of cigarettes. In particular, it is ensured that the respective marginal cigarettes lie in the regions of the angulations 37, 38 in a stabilizing manner, thus providing a positive-fitting support between the pack and the cigarettes. The planar wall surfaces of the pack of Focke do not disclose or suggest these features since the cigarettes abut the planar wall surfaces. Bohdan does not cure the deficiencies of Focke for at least the reasons which follow.

Bohdan discloses a cigarette arrangement for "oval packs," *i.e.*, for cigarette packs with fully rounded side walls. However, Bohdan provides no suggestion for adapting the same cigarette formation to the pack dimensions of a hinge-lid pack having the contour of the presently claimed exemplary embodiment. In fact, Bohdan fails to provide any strict correlation between pack contour and cigarette formation. Bohdan recommends the cigarette formation shown in FIG. 6 expressly for "*a channeling device ... which is also of oval shape.*" (column 3, lines 49, 50 and lines 52, 53). However, it is clear from the disclosure of Bohdan that the cigarette pack of Focke is not suited for the cigarette formation disclosed by FIG. 6 of Bohdan. Further, while Bohdan suggests that other configurations of the disclosed channeling device are

possible, Bohdan fails to disclose or suggest any cigarette formation suitable for any configuration other than the disclosed formation suited for packs of oval shape.

Thus, absent impermissible use of hindsight provided by Applicant's disclosure, it would not have been obvious to one of ordinary skill in the art at the time the invention was made to use the cigarette formation of Bohdan for an "*octagonal*" contour. Therefore, the pack configuration according to the claimed exemplary embodiment would not have been obvious based on the combined disclosure of Focke and Bohdan.

Accordingly, since the Examiner has not established a *prima facie* case of obviousness, the rejection of claim 18 over the combination of Focke and Bohdan is in error and should be withdrawn.

Similarly, claim 19 recites a hinge-lid pack for cigarettes with a "box part (11) and lid (12) are configured as having a matching octagonal cross-section, ... c) the material strips or legs (28, 29; 30, 31) are directed at an angle (39) of approximately 30° to the box front wall (14) and box rear wall (16), and to the lid rear wall (17) and lid front wall (19), respectively, and are directed at an angle (40) of approximately 60° to the transverse box side wall (22) and lid side wall (23)." Accordingly, Applicant submits that the rejection of independent claim 19 is also in error and respectfully requests that the rejection be withdrawn for the reasons set forth above with regard to claim 18.

Claims 12-15 and 20 depend from claim 18 and incorporate its limitations. Therefore, the rejection of claims 12-15 and 20 is also in error and should be withdrawn.

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The USPTO is directed and authorized to charge the statutory fee (37 C.F.R. §41.37(a) and 1.17(c)) and all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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23373
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Date: July 21, 2010

CLAIMS APPENDIX

CLAIMS 12-15 and 18-20 ON APPEAL:

12. The hinge-lid pack according to Claim 18, **characterized in that** the width of the side walls (22, 23) comprised of two overlapping side tabs (24, 25; 26, 27) is somewhat less than the dimensions of two adjacent cigarettes (10), in particular of the marginal first transverse row (35).

13. The hinge-lid pack according to Claim 18, **characterized by** the following features:

- a) the angulations (37) and/or the angulations (38) are each formed as rounded corners, namely with a circular-shaped rounding formed by curvature strips (45), specifically by conforming to the contour and dimension of the cigarettes (10) lying opposite the angulations (37, 38), and
- b) the angulations (37) bordering the side walls (22, 23) are rounded or configured as rounded corners and that the angulations (38) between the legs (28, 29; 30, 31), one hand, and the front side and rear side, on the other hand, have an angular configuration.

14. The hinge-lid pack according to Claim 18, **characterized in that**, in the case of rounded angulations (38), the side tabs (24, 25; 26, 27) extend exclusively in the region between the adjacent, rounded angulations (38) and overlap one another.

15. Hinge-lid pack according to Claim 18, **characterized in that** base corner tabs (46) and lid corner tabs (47) are arranged as the continuation of interior box side tabs (25) and lid side tabs (27), respectively, with the corner tabs (46, 47) being adapted to the contour of the base wall (15) and end wall (18) by means of corresponding exposed tab edges, or corresponding in their transverse dimensions to the width of their assigned side tabs (25, 27).

18. Hinge-lid pack for cigarettes (10) comprising a box part (11) with box front wall (14), a box rear wall (16), box side walls (22) and a base wall (15), a lid (12) which is pivotably attached to the box part (11) and which comprises a lid front wall (19), a lid rear wall (17), lid side walls (23) and an end wall (18), and a collar (13), made from a separate blank, being positioned within an upper part of the box part (11), **characterized by** the following features:

- a) the hinge-lid pack with box part (11) and lid (12) is configured as having an octagonal cross-section across its entire dimensions,
- b) a lateral region facing the box side walls (22) and lid side walls (23) is configured as having a cross-section that is trapezoid in shape, with converging material strips, namely legs (28, 29; 30, 31), connected respectively to the box front wall (14), box rear wall (16) and to the lid front wall (19) and lid rear wall (17),
- c) the width of the legs (28, 29; 30, 31) is greater than the diameter of one cigarette (10) yet less than the aggregate diameter of two adjacent cigarettes (10),
- d) the legs (28, 29; 30, 31) are directed at an angle (39) of approximately 30° to the box front wall (14) and box rear wall (16), and to the lid front wall (19) and lid rear wall (17),

respectively, and are directed at an angle (40) of approximately 60° to the transverse box side wall (22) and lid side wall (23),

- e) a cigarette group (34), as the pack's contents, comprises transverse rows of said cigarettes, namely transverse rows (35) with two adjacent cigarettes (10) and transverse rows (36) with three adjacent cigarettes (10),
- f) the cigarettes (10) of the adjacent transverse rows (35 and 36) are arranged in a saddle position, i.e. are offset to one another,
- g) cigarettes (10) of a marginal transverse row (35) of two adjacent cigarettes (10) are arranged in the region of angulations (37) between a box side wall (22) and lid side wall (23), on one hand, and box legs (28) and lid legs (30), on the other hand,
- h) marginal cigarettes of an adjacent transverse row (36) with three cigarettes (10) are arranged in the region of an angulation (38) between the box legs (28) and lid legs (30), on one hand, and box front wall (14), box rear wall (16), lid front wall (19) and lid rear wall (17), on the other hand.

19. Hinge-lid pack for cigarettes (10) comprising a box part (11) with box front wall (14), box rear wall (16), box side walls (22) and base wall (15), and a lid (12) which is pivotably attached to the box part (11) and which comprises lid front wall (19), lid rear wall (17), lid side walls (23) and end wall (18), **characterized by** the following features:

- a) box part (11) and lid (12) are configured as having a matching octagonal cross-section,

b) a region facing at least one of the box side walls (22) and lid side walls (23) is configured as having a cross-section that is trapezoid in shape, with converging material strips or legs (28, 29; 30, 31) connected respectively to the box front wall (14), box rear wall (16) and to the lid front wall (19) and lid rear wall (17), said legs (28, 29; 30, 31) having a width that is greater than the diameter of one cigarette (10) of said cigarettes and less than the aggregate diameter of two adjacent ones of said cigarettes (10).

c) the material strips or legs (28, 29; 30, 31) are directed at an angle (39) of approximately 30° to the box front wall (14) and box rear wall (16), and to the lid rear wall (17) and lid front wall (19), respectively, and are directed at an angle (40) of approximately 60° to the transverse box side wall (22) and lid side wall (23),

d) a collar (13) made from a separate blank conforms to the contour or cross-sectional profile in the region of the legs (28, 29; 30, 31) to form material strips (50, 51) that are arranged at an angle to one another,

e) attached to the marginal material strip (51) of the collar (13) is a collar leg (53) which abuts the inner side of the rear box legs (29) and lid legs (31).

20. Hinge-lid pack according to claim 18, wherein:

the collar (13) made from a separate blank conforms to the contour or cross-sectional profile in the region of the legs (28, 29; 30, 31) to form material strips (50, 51) that are arranged at an angle to one another, and

attached to a marginal material strip (51) of the collar (13) is a collar leg (53) which abuts the inner side of the rear box legs (29) and lid legs (31).

EVIDENCE APPENDIX:

Pursuant to 37 C.F.R. § 41.37(c)(1)(ix), submitted herewith are copies of any evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner and relied upon by Appellant in the appeal.

NONE.

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RELATED PROCEEDINGS APPENDIX

Submitted herewith are copies of decisions rendered by a court or the Board in any proceeding identified about in Section II pursuant to 37 C.F.R. § 41.37(c)(1)(ii).

NONE.

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SUBMISSION OF APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an Appeal Brief. The USPTO is directed and authorized to charge the statutory fee of \$540.00 and all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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